

FORM PTO-1390 (Modified)
(REV 11-2000)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

ATTORNEY'S DOCKET NUMBER

TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371

INVIT1220-1

U.S. APPLICATION NO. (IF KNOWN, SEE 37 CFR

09/937112

INTERNATIONAL APPLICATION NO.
PCT/US00/06560INTERNATIONAL FILING DATE
13/03/00PRIORITY DATE CLAIMED
19/03/99

TITLE OF INVENTION

METHODS OF OBTAINING FULL-LENGTH NUCLEIC ACID SEQUENCES USING E. COLI TOPOISOMERASE
III AND ITS HOMOLOGS

APPLICANT(S) FOR DO/EO/US

HEYMAN ET AL.

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (24) indicated below.
4. ☒ The US has been elected by the expiration of 19 months from the priority date (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371 (c) (2))
 - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☒ has been communicated by the International Bureau.
 - c. ☒ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☐ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☒ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
10. ☐ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).
11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☒ A copy of the International Search Report (PCT/ISA/210).

Items 13 to 20 below concern document(s) or information included:

13. ☒ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☐ A **FIRST** preliminary amendment.
16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
17. ☐ A substitute specification.
18. ☐ A change of power of attorney and/or address letter.
19. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 35 U.S.C. 1.821 - 1.825.
20. ☐ A second copy of the published international application under 35 U.S.C. 154(d)(4).
21. ☐ A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
22. ☒ Certificate of Mailing by Express Mail
23. ☒ Other items or information:

FORM PTO-1449 (2 pgs.)

19 References

Express Mail Label No.: EL617042403US

Check No. 489757

U.S. APPLICATION NO. (IF KNOWN, SEE 37 CFR 1.492(a)(1)) <div style="font-size: 24pt; font-weight: bold;">09/93711</div>	INTERNATIONAL APPLICATION NO. <div style="font-weight: bold;">PCT/US00/06560</div>	ATTORNEY'S DOCKET NUMBER <div style="font-weight: bold;">INVIT1220-1</div>
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24. The following fees are submitted: BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) - (5)) : <input type="checkbox"/> Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO and International Search Report not prepared by the EPO or JPO \$1000.00 <input checked="" type="checkbox"/> International preliminary examination fee (37 CFR 1.482) not paid to USPTO but International Search Report prepared by the EPO or JPO \$860.00 <input type="checkbox"/> International preliminary examination fee (37 CFR 1.482) not paid to USPTO but international search fee (37 CFR 1.445(a)(2)) paid to USPTO \$710.00 <input type="checkbox"/> International preliminary examination fee (37 CFR 1.482) paid to USPTO but all claims did not satisfy provisions of PCT Article 33(1)-(4) \$690.00 <input type="checkbox"/> International preliminary examination fee (37 CFR 1.482) paid to USPTO and all claims satisfied provisions of PCT Article 33(1)-(4) \$100.00 <div style="text-align: right; font-weight: bold;">ENTER APPROPRIATE BASIC FEE AMOUNT =</div>				CALCULATIONS PTO USE ONLY <div style="border: 1px solid black; height: 100px; width: 100%;"></div>																																																																													
Surcharge of \$130.00 for furnishing the oath or declaration later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date (37 CFR 1.492 (e)).				\$860.00																																																																													
<table border="1" style="width:100%; border-collapse: collapse;"> <thead> <tr> <th style="width:15%;">CLAIMS</th> <th style="width:20%;">NUMBER FILED</th> <th style="width:20%;">NUMBER EXTRA</th> <th style="width:10%;">RATE</th> <th style="width:15%;"></th> <th style="width:10%;"></th> </tr> </thead> <tbody> <tr> <td>Total claims</td> <td>34 - 20 =</td> <td>14</td> <td>x \$18.00</td> <td>\$252.00</td> <td></td> </tr> <tr> <td>Independent claims</td> <td>3 - 3 =</td> <td>0</td> <td>x \$80.00</td> <td>\$0.00</td> <td></td> </tr> <tr> <td colspan="4">Multiple Dependent Claims (check if applicable) <input type="checkbox"/></td> <td>\$0.00</td> <td></td> </tr> <tr> <td colspan="4" style="text-align: right;">TOTAL OF ABOVE CALCULATIONS =</td> <td>\$1,112.00</td> <td></td> </tr> <tr> <td colspan="4"> <input type="checkbox"/> Applicant claims small entity status. (See 37 CFR 1.27). The fees indicated above are reduced by 1/2. </td> <td>\$0.00</td> <td></td> </tr> <tr> <td colspan="4" style="text-align: right;">SUBTOTAL =</td> <td>\$1,112.00</td> <td></td> </tr> <tr> <td colspan="4" style="padding: 5px;"> Processing fee of \$130.00 for furnishing the English translation later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date (37 CFR 1.492 (f)). </td> <td colspan="2" style="text-align: center; padding: 5px;"> \$0.00 </td> </tr> <tr> <td colspan="4" style="text-align: right;">TOTAL NATIONAL FEE =</td> <td>\$1,112.00</td> <td></td> </tr> <tr> <td colspan="4" style="padding: 5px;"> Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31) (check if applicable). <input type="checkbox"/> </td> <td colspan="2" style="text-align: center; padding: 5px;"> \$0.00 </td> </tr> <tr> <td colspan="4" style="text-align: right;">TOTAL FEES ENCLOSED =</td> <td>\$1,112.00</td> <td></td> </tr> <tr> <td colspan="4"></td> <td style="text-align: center;">Amount to be refunded</td> <td style="text-align: center;">\$</td> </tr> <tr> <td colspan="4"></td> <td style="text-align: center;">charged</td> <td style="text-align: center;">\$</td> </tr> </tbody></table>				CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE			Total claims	34 - 20 =	14	x \$18.00	\$252.00		Independent claims	3 - 3 =	0	x \$80.00	\$0.00		Multiple Dependent Claims (check if applicable) <input type="checkbox"/>				\$0.00		TOTAL OF ABOVE CALCULATIONS =				\$1,112.00		<input type="checkbox"/> Applicant claims small entity status. (See 37 CFR 1.27). The fees indicated above are reduced by 1/2.				\$0.00		SUBTOTAL =				\$1,112.00		Processing fee of \$130.00 for furnishing the English translation later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date (37 CFR 1.492 (f)).				\$0.00		TOTAL NATIONAL FEE =				\$1,112.00		Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31) (check if applicable). <input type="checkbox"/>				\$0.00		TOTAL FEES ENCLOSED =				\$1,112.00						Amount to be refunded	\$					charged	\$
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- a. ☒ A check in the amount of \$1,112.00 to cover the above fees is enclosed.
- b. ☐ Please charge my Deposit Account No. _____ in the amount of _____ to cover the above fees. A duplicate copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-1355 A duplicate copy of this sheet is enclosed.
- d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO: <div style="border: 1px solid black; padding: 5px;"> Lisa A. Haile, J.D., Ph.D. GRAY CARY WARE & FREIDENRICH LLP 4365 Executive Drive, Suite 1600 San Diego, California 92121-2189 </div>	<div style="text-align: center;"> <div style="border-top: 1px solid black; width: 100%;"></div> SIGNATURE </div> <div style="margin-top: 20px;"> <div style="border-top: 1px solid black; width: 100%;"></div> Richard J. Imbra NAME </div> <div style="margin-top: 20px;"> <div style="border-top: 1px solid black; width: 100%;"></div> 37,643 REGISTRATION NUMBER </div> <div style="margin-top: 20px;"> <div style="border-top: 1px solid black; width: 100%;"></div> 19 September 2001 DATE </div>
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: INVITORGEN CORPORATION
Serial No.: Unassigned
Filed: 19 September 2001
Title: METHODS OF OBTAINING FULL-LENGTH NUCLEIC ACID SEQUENCES
USING E. COLI TOPOISOMERASE III AND ITS HOMOLOGS

Assistant Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I, Mikhail Bayley declares as follows:

1. I reside at 4551 W. TAYLOR DR
and am an employee of Gray Cary Ware & Freidenrich LLP, 4365 Executive Drive, Suite 1600,
San Diego, CA 92121-2189.

2. I hereby certify that on **September 19, 2001**, I deposited in the mail, "Express
Mail Post Office to Addressee" service of the United States Postal Service the contents of the
envelope for which "Express Mail" receipt No. **EL617042403US** was addressed to: Assistant
Commissioner of Patents, Washington, D.C. 20231, BOX PCT.

3. Attached hereto is a true copy of the "Express Mail" receipt no.
EL617042403US.

I hereby declare that all statements made herein of my own knowledge are true and that
all statements made on information and belief are believed to be true; and further that these
statements were made with the knowledge that willful false statements and the like so made are
punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States
Code and that such willful false statements may jeopardize the validity of the above-identified
application or any patents issued thereon.

Date: 09/19/2001

Mikhail Bayley